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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,055	12/31/2001	Rajendran S. Michael	25143A	9092 8
22889	7590'	10/02/2003	EXAMINER	
OWENS CORNING			CHEVALIER, ALICIA ANN	
2790 COLUMBUS ROAD			ART UNIT	
GRANVILLE, OH 43023			PAPER NUMBER	

1772

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

CF

Office Action Summary

Application No.

10/039,055

Applicant(s)

MICHAEL ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u> . | 6) <input type="checkbox"/> Other: |

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The 35 U.S.C. §112 rejections of claims 2 and 14 of record in paper #5, page 3, paragraph #7 have been withdrawn due to Applicant's amendment in paper #6.

REJECTIONS REPEATED

2. The 35 U.S.C. §102 rejection of claims 1-8 and 13-20 as anticipated by Tanaka et al. (5,258,089) is repeated for reasons previously of record in paper #5, page 4, paragraph #9.

Tanaka discloses an interior-finishing material for use in automobiles comprising a surface material (polymer trim panel) and a sheath formed of a co-fiberized composite material comprising a mixture of entangled glass (mineral) and organic fibers (col. 3, lines 7-13, abstract, and figure 1). The organic fibers can be fibers such as polyethylene or polyester fibers (col. 3, lines 9-13). The surface material comprises polyurethane foam (col. 4, lines 35-42). From figures 5 and 6 it can be seen that the interior-fishing material has U-shape.

Example 1 teaches preparing the composite material with 90 parts by weight of glass fibers and 10 parts by weight polyester fibers to obtain a sheet thickness of 6 mm and a density of 550 g/m².

In regard to the limitations "capable of absorbing a portion of impact energy created during collision" and "adapted to be positioned adjacent to a vehicle pillar," it has been held that the recitation that an element is "adapted to" or "capable of" perform/performing a function is not a positive limitation but only requires the ability to so perform. *In re Hutchison*, 69 USPQ

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138. Since, Tanaka meets all the structural limitations of the claims it is inherent that Tanaka is capable of absorbing a portion of impact energy created during collision and adapted to be positioned adjacent to a vehicle pillar.

Regarding the new limitation “having a semi-compacted thickness less than an initial prepared thickness,” Tanaka also anticipates this limitation. Tanaka discloses that the interior-finishing material under goes cold compression (semi compacting), see attached pages of Concise Encyclopedia of Polymer Science and Engineering. The “thickness less than an initial prepared thickness” is merely a process limitation and does not add structure to the element. The method of forming the product is not germane to the issue of patentability of the product itself. Therefore, since the interior-finishing material is semi-compacted and has the same thickness of the final product it is irrelevant where the material was initially thicker or not.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable

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even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “having ... thickness less than an initial prepared thickness” – claim 1 is a method of production and therefore does not determine the patentability of the product itself.

3. The 35 U.S.C. §103 rejection of claim 21 over Tanaka et al. (5,258,089) is repeated for reasons previously of record in paper #5, page 5, paragraph #11.

Tanaka discloses all the limitations of the instant claimed invention except for the trim panel resin has a density from about 0.5 g/cm³ to about 1.5 g/cm³. Since Tanaka also uses a polyurethane resin, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polyurethane resin with a density of from about 0.5 g/cm³ to about 1.5 g/cm³, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended. *In re Leshin*, 125 USPQ 416.

NEW REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (5,258,089) in view of Carroll, III et al. (6,017,084).

Tanaka discloses all the limitations of the instant claimed invention except that the sheath has an HICd value of less than about 1000.

Carroll discloses that the “head Injury Criterion” (HICd) is a plot of acceleration vs. time which is used to measure the performance of a human headform impacting the interior of a motor vehicle and is calculated according to Federal Motor Vehicle Safety Standard 201. If the performance of a headform is measured upon impact with the unitized body or cage of a motor vehicle lacking any trim cover or energy absorbing members, HICd is typically measured to be greater than 2000, and sometimes above 3000. HICd can be lower if the cage is relatively flexible, the headform hits at a glancing angle, or an aesthetic trim cover is installed. Designers prefer HICd to be less than 1000, and sometimes less than 800. See column 5, lines 14-30.

The exact HICd value of the sheath is deemed to be a cause effective variable with regard flexibility of the sheath. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as HICd value of the sheath through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the teaching of Carroll to optimize the HICd value below 1000 of Tanaka because of the improved impacted performance.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments regarding the 35 U.S.C. §112 rejections of record have been considered but are moot since the rejections have been withdrawn.

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7. Applicant's arguments regarding the 35 U.S.C. §102 and §102 rejections of record have been considered but are moot due to the new grounds of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9306. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

9/21/03



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

9/22/03